

R E M A R K S**A. INTRODUCTION**

This paper is responsive to the Office Action mailed on August 11, 2008 (hereinafter the "Office Action"). Applicants thank the Examiner for withdrawing the objection to claim 33 in view of our prior amendment, and for withdrawing the prior Section 112, first paragraph rejection.

Claims 1-7, 12-43, 47-59, 61-72, 74-79, 82-104 and 108-126 are pending and have been rejected.

Claims 8-11, 44-46, 60, 73, 80, 81 and 105-107 were previously cancelled.

Upon entry of this Amendment:

- Claims 1-7, 12-43, 47-59, 61-72, 74-79, 82-104 and 108-126 will be pending;
- Claims 1, 2, 13, 15, 17, 19, 22, 28, 30, 33, 35, 47, 48, 74, 108, 119 and 123-126 will be amended; and
- Claims 1, 2, 13, 15, 17, 19, 22, 28, 30, 33, 35, 47, 48, 74, 108, 119, and 123-126 will be the independent claims.

B. PRIORITY INFORMATION

The Examiner is correct that inventor Magdalena Fincham does not appear in other parent applications, but Applicants respectfully note that inventor Jay Walker does appear as an inventor on the parent applications (except for U.S. Application no. 09/947,798), and that all of the parent cases are owned by virtue of assignment by the same entity as the present application. Accordingly, Applicants respectfully submit that the present application should be accorded the requisite priority date(s) for features that appear in the pending claims that have been disclosed in those parent cases.

C. SECTION 112 ¶ 1 REJECTION: LACK OF WRITTEN DESCRIPTION/ENABLEMENT

Claims 1-7, 12-43, 47-59, 61-72, 74-79, 82-104 and 108-126 have been rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains to make and/or use the invention. Specifically, the Examiner states:

“The claims refer to “... the at least one secondary product does not have a pre-established relationship with the primary product...” For purposes of Examination, prior art is interpreted to meet the limitation where prior art discloses that a secondary product is not currently selected for purchase.” [Office Action, page 10].

Applicants respectfully traverse, as the present application supports the limitation of *wherein the at least one secondary product does not have a pre-established relationship with the primary product*. For example, on page 5, line 19 to page 6, line 4, it is explained that various considerations can be used to determine a package, including selecting each product (a primary product and a secondary product) from a different department of a retailer (i.e. one product from the deli department and another from the house wares department). Such products would not be expected to share any pre-established relationship. Furthermore, the application discloses on page 33, lines 23-30 that the secondary products of a package may have no relationship to the primary product (other than a monetary relationship), so that a package could include, for example, a television (the primary product) and a shovel (the secondary product). Applicants respectfully submit that one skilled in the art, upon reading these descriptions, would readily understand that a package could be assembled wherein the secondary product does not have a pre-established relationship with the primary product.

Furthermore, independent claims 1, 2, 13, 15, 17, 19, 22, 28, 30, 33, 35, 74, 124, 125 and 126 have been amended (in a similar manner) to more particularly claim the invention. For example, claim 1, which is illustrative, now recites:

detecting, by a central server, that a primary product is of interest to a customer, the primary product having an associated primary product identifier;

in response to detecting that the primary product is of interest to the customer, the central server dynamically determining a package on an ad hoc basis to be offered to the customer, the package comprising the primary product and at least one secondary product, the primary product and the at least one secondary product each having a corresponding retail price, ...

*wherein at least one of the at least one secondary product is selected for inclusion in the package based on an indication of **past** interest, by the customer, in at least one secondary product, and further... (Emphasis added)*

Support for such changes can be found, for example, on page 8, lines 9-11; page 9, line 9 to page 14, line 27; and in Figs. 1A -1C (central server); on page 15, lines 3-5; page 23, lines 8-10; page 26, lines 23-26; page 31, lines 19-21; and on page 35, lines 23-24 (the central server dynamically determining a package on an ad hoc basis); on page 18, lines 8-11; page 26, lines 17-21; and on page 31, lines 12-14 (secondary product selected for inclusion based on an indication of past interest by the customer in a secondary product). Thus, no new matter has been added. We note that, with the exception of the phrases “a central server” and “the central server”, independent computer readable medium claims 2, 13, 15, 17, 19, 22, 28, 30, 33, 35 and 124, and independent system claims 74 and 126 have been amended in a similar manner.

In addition, independent claims 119 and 123 has been amended to recite that the central server *dynamically* determines the package *on an ad hoc basis*, and independent claims 47, 48, 108 have been amended to recite that the secondary product is selected for inclusion in the package based on *past interest* by the customer in at least one secondary product. Examples of where support can be found for these changes in the present application have been recited above, and thus no new matter has been added.

Lastly, claims 47 and 125 have been amended to include the phrases “by a customer device” and “by the customer device”. Support for such changes can be found, for example, on page 8, lines 26-29, and in Figs. 1A, 1B and 1C and accompanying text. No new matter has been added.

Applicants respectfully submit that the current amendments inform the limitation of the independent claims of *wherein the at least one secondary product does not have a pre-established relationship with the primary product*, because the central server is not constrained when dynamically determining a package on an ad hoc basis. In particular, a secondary product is selected that does not have a pre-established relationship with the primary product.

With respect to claims 1, 47, 74, 83, 119-124, and 125-126, Applicants respectfully reassert that reasonably particular language has been used to describe features by which a customer’s interest may be indicated, detected, or interpreted. In addition, various examples of how interest in a product may be determined, interpreted, detected, relied upon, or indicated, based on various types of available information are provided by the present application. For example, detecting that a primary product is of interest to the customer may involve detecting that information is displayed on a web-page being viewed by the customer, or detecting an input

signal generated by the customer, or detecting that the customer has added the primary product to a virtual shopping cart (see page 6, lines 12-22). Other descriptions of customer interest can be found, for example, on page 15, lines 3-16, and on page 20, line 25 to page 21, line 13. Accordingly, we respectfully submit that one skilled in the art, upon reading the present disclosure, would readily understand the language used in the pending claims that refer to detecting and indication a customer's interest in a product.

In view of the above amendments and for at least the above reasons, Applicants respectfully request reconsideration and withdrawal of the Section 112, paragraph 1 rejection of the pending claims.

D. SECTION 112 ¶2 REJECTION: INDEFINITENESS

Claims 1-7, 12-43, 47-59, 61-72, 74-79, 82-104 and 108-126 have been rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite. Applicants respectfully traverse.

As explained immediately above in Part C of this paper, the limitation of *wherein the at least one secondary product does not have a pre-established relationship with the primary product* is supported and enabled by the present application. Applicants admit that some embodiments described in the present specification show secondary products that are in a pre-established relationship with a primary product, but we respectfully point out that those embodiments are not at issue here. That is, the pending claims are directed to other disclosed embodiments.

The present application discloses embodiments wherein a package is assembled on an ad hoc basis (see page 26, lines 25-26), and further wherein the secondary product is selected for inclusion in the package based on, for example, profit margin considerations that have nothing to do with the relationship of the primary and secondary products (see application, page 33, lines 12-30). In such a case disparate products, such as a television, a shovel, and a sweater, may all be included in a package offer. Thus, Applicants respectfully submit that claims 1-7, 12-43, 47-59, 61-72, 74-79, 82-104 and 108-126 are not indefinite.

For at least the above reasons, Applicants respectfully request reconsideration and withdrawal of the Section 112, paragraph 1 rejection of the pending claims.

E. THE SECTION 102(E) REJECTIONS

Claims 1-2, 4-7, 14-15, 18-19, 21-22, 25-31, 47-49, 51-54, 57, 68, 72, 74, 76-79, 83, 87, 90-94, 108 and 111-113 stand rejected under 35 U.S.C. 102(e) as being anticipated by Blinn (U.S. Patent No. 5,897,622).

As explained above, independent claims 1, 2, 15, 19, 22, 28, 30, 47, 48, 74, and 108 have been amended herein. Each of these claims now generally recites:

*in response to detecting that the primary product is of interest to the customer, dynamically determining a package **on an ad hoc basis** to be offered to the customer, the package comprising the primary product and at least one secondary product, the primary product and the at least one secondary product each having a corresponding retail price,*
...

*wherein at least one of the at least one secondary product is selected for inclusion in the package based on an indication of **past** interest, by the customer, in at least one secondary product, and further... (Emphasis added)*

Applicants respectfully submit that Blinn does not teach or suggest such features. Instead, Blinn is limited to offering to a customer a cross-sell product, that is associated in a database with the product selected for purchase by the customer. For example, in an implementation, if the customer selects a hat, then the cross-sell product is a scarf (see Blinn, col. 21, line 62 to col. 22, line 45 and Fig. 13B). Only cross-sell products that a merchant had previously associated in a database with the product selected for purchase by the customer are offered to the customer in Blinn. This occurs regardless of whether the customer had indicated any past interest (or any interest at all) in the cross-sell product. This is because Blinn discloses a strictly database-driven system, and it does not describe tracking of a customer's interests, much less tracking selections of products for the purpose of later including the product in a package being offered to the customer.

In stark contrast, pending independent claims 1, 2, 15, 19, 22, 28, 30, 47, 48, 74, and 108 have been amended herein to recite that at least one secondary product is selected for inclusion in the package *based on past interest* by the customer in at least one secondary product. Since such a feature is not taught by Blinn, thus these claims are not anticipated for at least this reason.

Furthermore, claims 1, 2, 15, 19, 22, 28, 30 and 74 generally require *in response to detecting that the primary product is of interest to the customer, dynamically determining a package on an ad hoc basis to be offered to the customer, the package comprising the primary product and at least one secondary product, the primary product and the at least one secondary product each having a corresponding retail price*. Blinn is devoid of any such feature, as it does not suggest or teach to dynamically determine a package on an ad hoc basis (because all of the packages in Blinn are predetermined).

Accordingly, Applicants respectfully request reconsideration and withdrawal of the Section 102(e) rejections of all of the independent claims 1, 2, 15, 19, 22, 28, 30, 47, 48, 74, and 108 (and their associated dependent claims).

F. SECTION 103(A) REJECTIONS

1.01. Claims 3, 12-13, 16-17, 20, 23-24, 32-33, 36-43, 50, 58-67, 75, 82, 84-86, 88-89, 95-104, 109, 110, and 115-117 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Blinn.

Each of independent computer readable medium claims 13, 17 and 33 each have been amended, and each one includes:

in response to detecting that the primary product is of interest to the customer, dynamically determining a package on an ad hoc basis to be offered to the customer, the package comprising the primary product and at least one secondary product, the primary product and the at least one secondary product each having a corresponding retail price...

*wherein at least one of the at least one secondary product is selected for inclusion in the package based on an indication of **past interest**, by the customer, in at least one secondary product, and further...(Emphasis added)*

As explained above, Blinn does not teach or suggest such features, and thus claims 13, 17 and 33 are patentably distinct thereover. Furthermore, independent claims 1 and 74 require these features, and therefore each of dependent claims 3, 12, 16, 18, 23, 24, 32 and 36-43 (which each directly or indirectly depends on claim 1), and each of dependent claims 75, 82, 84-86, 88, 89, 95-104 (which each directly or indirectly depends on claim 74) are patentably distinct over Blinn for at least the same reasons.

Furthermore, independent claims 47 and 108 have been amended to recite that at least one of the at least one secondary product is selected for inclusion in the package *based on an indication of a past interest by the customer*, which is not taught or suggested by Blinn, as explained above. Accordingly, each of dependent claims 50, 58-67 (which directly or indirectly depends on claim 47), and each of dependent claims 109, 110 and 115-117 (which directly or indirectly depends on claim 108) is patentably distinct from Blinn for at least the same reason.

In view of the above amendments and remarks, Applicants respectfully request reconsideration and withdrawal of the Section 103(a) rejections of claims 3, 12-13, 16-17, 20, 23-24, 32-33, 36-43, 50, 58-67, 75, 82, 84-86, 88-89, 95-104, 109, 110, and 115-117.

1.02. Claims 16, 17, 34 and 35 stand rejected as being unpatentable over Blinn and in further view of Gupta (U.S. Patent No. 6,820,062).

Dependent claims 16 and 34 (which depend on claim 1), and independent computer readable medium claims 17 and 35 (which have been amended, as explained above) were rejected as being obvious in view of Blinn and Gupta.

Applicants respectfully submit that Gupta does not cure the deficiencies of Blinn explained above. In particular, Gupta does not suggest or teach the feature of: *in response to detecting that the primary product is of interest to the customer, dynamically determining a package on an ad hoc basis to be offered to the customer, the package comprising the primary product and at least one secondary product, the primary product and the at least one secondary product each having a corresponding retail price*, nor does Gupta or Blinn, either alone or in combination, suggest or teach *wherein at least one of the at least one secondary product is selected for inclusion in the package based on an indication of past interest, by the customer, in the at least one secondary product*, as required by independent claims 1 and 35. Accordingly, claims 1 and 35 are patentably distinct thereover. In addition, dependent claims 16 and 34 should be allowable for at least the same reasons.

Furthermore, contrary to the Examiner's assertion, nothing in the cited portion or otherwise in Blinn teaches or suggests "storing in a database information relating to a previous transaction of a customer, the previous transaction including at least one previous sold product" (see Office Action, page 35). In particular, the cited portion of Blinn (col. 21, lines 6-34) describes a portion of Fig. 15a and Fig. 15b, which shows pseudo code for an action, and order and an annotated order (Fig. 15a), and pseudo code for a template portion, an order, an access

object and a page portion (Fig. 15b), wherein both of these figures together illustrate the data flow of Fig. 14. The disclosed process merely keeps track of the customer's ongoing order, and there is no teaching or suggestion that the order data is saved for any future use after the transaction is completed.

In view of the above amendments to claims 1, 17 and 35 and the associated remarks, we respectfully request withdrawal of the Section 103(a) rejections of claims 16, 17, 34 and 35.

1.03. Claims 44-46, 54-56, 69-72, 105-107, 114 and 118 stand rejected as being unpatentable over Blinn and in further view of Tice (an article entitled "Web Ordering May Alter Role of Distributors", published June 22, 1998).

Claims 44-46, 54-56, 69-72, 105-107, 114 and 118 stand rejected as being unpatentable over Blinn and in further view of Tice.

Claims 44-46 and 105-107 were cancelled previously, and thus this rejection is moot as to those claims.

Although Tice describes having customers order products over the internet directly from manufacturers, and to have them shipped either to the store or the customer's home (see paragraph spanning page 2 to page 3), it does not cure the deficiencies of Blinn discussed above. In particular, neither Blinn nor Tice, either alone or in combination, teaches or suggests the features of:

*wherein at least one of the at least one secondary product is selected for inclusion in the package **based on an indication of past interest**, by the customer, in at least one secondary product, and further.. (Emphasis added)*

This feature is recited in both independent claims 47 and 108, which are thus patentably distinct from Blinn and Tice. Accordingly, since each of claims 54-56, 69-72 and 105-107 directly or indirectly depends on claim 47, and since each of claims 114 and 118 directly or indirectly depends on claim 108, these dependent claims should be allowable for at least the same reasons.

In view of the above remarks, applicants respectfully request withdrawal of the Section 103(a) rejection of claims 54-56, 69-72, 114 and 108.

1.04. Claims 119-126 stand rejected as being unpatentable over Blinn and further in view of Bernard (U.S. Patent No. 5,918,213).

Independent claims 119 and 123-126 have been amended. In particular, each of claims 119, 123, 124 and 126 now generally requires:

in response to detecting the loss of interest in the primary product, dynamically determining a package on an ad hoc basis to be offered to the customer, the package comprising the primary product and at least one secondary product, the primary product and the at least one secondary product each having a corresponding retail price;

First, neither Blinn nor Bernard, whether taken alone or in combination, teaches or suggests the feature highlighted above. Thus, claims 119, 123, 124 and 126 are patentably distinct thereover, for at least this reason. In addition, dependent claims 120-122 should be allowable for at least the same reason as claim 119.

Second, claims 123, 124, 125 and 126 each includes the feature of *wherein the at least one secondary product was selected based on a past interest of the customer*. Neither Blinn nor Bernard, whether taken alone or in combination, teaches or suggests such a feature. Accordingly, these claims are patentably distinct over the cited art for at least this reason.

Third, the Examiner admits that: “Blinn does not specifically disclose detecting a loss of interest in the primary product by the customer and that determining a package to be offered to a customer occurs in response to detecting the loss of interest in the primary product.” [Office Action, page 40]. But the Office Action then recites that “Bernard discloses tracking events such as when a customer removes items from a shopping, thereby detecting a loss of interest in a primary product by customers. See, for example, Col. 33, lines 4-63.” [Office Action, page 40].

As we noted in our previous response, the cited portion of Bernard states:

“VRU 104 may prompt the caller to either put the selections which are on hold back into the virtual shopping cart or to delete the selection from the list of items on hold.” Column 33, lines 13-16.

Accordingly, Bernard possibly might have suggested, to one of ordinary skill, identifying a selection that is “on hold,” and somehow prompting a caller to either place the selection back into a virtual shopping cart or to delete the selection. But contrary to the Examiner’s assertion, nothing in the cited portion or otherwise in Bernard teaches or suggests “tracking” events such as

a customer removing an item from a shopping cart. At best, there is a suggestion of a list of items “on hold.” There is no suggestion that deletion of an item “on hold” is a “tracked” event.

Fourth, we respectfully reassert that Bernard does not teach or suggest *determining a package to be offered to the customer in response to detecting the loss of interest in the primary product*. There is no suggestion of doing anything in response to having items “on hold” other than the explicitly described prompt to the caller, much less determining a package of any kind to offer a customer (or presenting a package offer to the customer, wherein the package includes a primary product and a secondary product that was selected based on a past interest of the customer).

As described in the cited portion of Bernard, a caller is given a choice only between deleting an item from an “on hold” list or putting it back in a shopping cart. Nothing in Bernard suggests doing anything else with an item a caller wants “discarded”—except deleting it from the “on hold” list.

Applicants again submit that there is no hint in either of Blinn or Bernard that either reference teaches the limitations of independent claims 119, 123, 124, 125, and 126. Accordingly, to the extent that only Blinn and Bernard are relied upon as teaching all the features of claims 119, 123, 124, 125, and 126, Applicants respectfully assert that the Section 103(a) rejection cannot stand. No evidence of all such features has been provided, much less substantial evidence. Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness, as neither Blinn nor Bernard, alone or in combination, cannot support such a rejection. The Section 103(a) rejection fails for at least this reason.

Sixth, no substantial evidence of record has been provided that one skilled in the art would be motivated to combine the electronic shopping and merchandising system of Blinn with the automated product purchasing telephone system of Bernard in the manner suggested by the Examiner, to provide specifically for the feature of *in response to detecting the loss of interest in the primary product, dynamically determining a package on an ad hoc basis to be offered to the customer, the package comprising the primary product and at least one secondary product, the primary product and the at least one secondary product each having a corresponding retail price*. Thus, no substantial evidence of record has been provided of an apparent reason to combine or modify the references in any manner that renders any of claims 119, 123, 124, 125 and 126 obvious. Accordingly, a *prima facie* case of obviousness has not been established.

In fact, even if the references were combined in the manner suggested, the proposed combination would fail to teach *in response to detecting the loss of interest in the primary product, determining a package to be offered to the customer, the package comprising the primary product and at least one secondary product, the primary product and the at least one secondary product each having a corresponding retail price*. Nothing in any reference of record even hints at such operation. In fact, the Examiner has failed to show that any reference of record determines a package in response to determining the loss of interest in the primary product. As such, any combination of the references of record fails to teach this limitation.

For any one of the above listed reasons, Applicants respectfully request withdrawal of the Section 103(a) rejection of claims 119-126.

G. ADDITIONAL COMMENTS

Our silence with respect to the Examiner's other various assertions not explicitly addressed in this paper, including assertions of what the cited reference(s) teach or suggest, the Examiner's interpretation of claimed subject matter or the Specification, or the propriety of any asserted combination(s) of teachings, is not to be understood as agreement with the Examiner. As the Examiner has not established an un rebuttable *prima facie* case for rejecting any of the claims as pending, for at least the reasons stated in this paper, we need not address all of the Examiner's assertions at this time. Also, the absence of arguments for patentability other than those presented in this paper should not be construed as either a disclaimer of such arguments or as an indication that such arguments are not believed to be meritorious.

**H. PETITION FOR EXTENSION OF TIME TO RESPOND & AUTHORIZATION TO CHARGE
APPROPRIATE FEES**

Applicants herein petition for a one-month extension of time to respond, and authorize the Commissioner to charge Deposit Account No. 50-0271; Order No. 99-004 for the surcharge fee. We do not believe that any other fees are due, but if a fee should be necessary to continue prosecution of the present application, please also charge any such required fee to our Deposit Account No. 50-0271. In addition, please credit any overpayment to the same Deposit Account No. 50-0271.

I. CONCLUSION

Applicants respectfully request favorable reconsideration and allowance of all of the pending claims.

If the Examiner has any questions regarding this Amendment and Response or the present application, the Examiner is cordially requested to contact Stephan Filipek at telephone number (203) 461-7252 or via electronic mail at sfilipek@walkerdigital.com.

Respectfully submitted,

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Date

/Stephan J. Filipek, Reg. No. 33,384/
Stephan J. Filipek
Attorney for Applicants
Registration No. 33,384
sfilipek@walkerdigital.com
(203) 461-7252/voice
(203) 461-7300/fax